

**REMARKS**

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 8-11, 15, 17 and 18 have been amended, as set forth herein.

Claim 16 has been canceled, without prejudice.

**I. REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1, 2, 7-11 and 15-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee (US Patent No. 5,524,137) in view of Ativanichayaphong (US Patent Application Publication No. 2004/0236575) (hereinafter "Wilson"). Claims 3, 4, 12-14, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee in view of Wilson, and in further view of Lor (US Patent No. 6,201,562). Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee in view of Wilson, and in further view of Ejima (US Patent No. 6,259,469). Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rhee in view of Wilson, and in further view of Turak (US Patent Application Publication No. 2003/0232245). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Rhee is directed to a multi-media messaging system enabling a user to select the communication format in which a stored message will be received by the user (the stored message may be delivered in a format different from the stored format, e.g., video to audio, one language to another language). Rhee, Abstract. While Rhee describes video or audio prompts (or menus), such prompts appear only tangentially related to the main purpose of Rhee, which is, switching the format of stored messages to a format selected by the user (depending on the communication capabilities the user terminal). Rhee, Abstract, Col. Thus, the main thrust of Rhee is directed to changing

communication formats for stored messages - not multimedia prompting as described in Applicant's specification.

Independent Claims 1, 8 and 15 have been amended to more particularly point out and distinctly claim the subject matter Applicant regards as the invention.

Claim 1 now recites, generally: (1) receiving first information from a video client, (2) receiving second information from the video client, and (3) providing a dynamic multimedia prompt to the video client, the dynamic multimedia prompt comprising a first video clip and first audio information associated with the first video clip, at least a portion of the dynamic multimedia prompt selected based at least partially on the information received from the video client, and a second video clip including at least a portion of the second information received from the video client.

Claim 8 now recites, generally, (1) receiving first information from a video client, the first information associated with a service requested by the video client, (2) receiving second information from the video client; and (3) providing a dynamic multimedia prompt to the video client, the dynamic multimedia prompt comprising a first video clip and first audio information associated with the first video clip, at least a portion of the dynamic multimedia prompt selected based at least partially on the first information received from the video client, and a second video clip including at least a portion of the second information received from the video client. Amended Claim 15 is similar to Claim 8.

Rhee fails to disclose providing a prompt including a first video clip (and audio information associated with the first video clip) and a second video clip, where the second video clip includes at least a portion of information received from the video client in response to the first video clip. In Rhee, the system merely provides either a video or audio prompt to a terminal apparatus (step 303), receives user input to select a language, provides a prompt to select a communications format (step 305), receives user input (e.g. user is at a video terminal), provides a video prompt for user login (steps 307, 309) and receives input, provides a video menu prompt describing the message types the user can obtain (step 311, fax, image, audio or text), . . . , provides a video prompt whether to receive the stored message in the original stored language or a different language (step 319), ..., and then

delivers the stored message to the user's terminal. Rhee, Figure 3, Col. 4, line 47 through Col. 5, line 42. Nothing therein appears to disclose, describe or suggest that information received from a video client in response to a first video clip is provided in a second video clip back to the user of the video client (such as for confirmation or verification purposes). Moreover, Rhee does not disclose or teach a prompt also including audio information associated with the first video clip.

Similarly, Wilson does not disclose dynamic prompts having both a video clip and associated audio information. Wilson appears to utilize only visual prompts in response to speech input to confirm the speech input. Wilson, Abstract, Figure 1.

As set forth above, Rhee fails to disclose one or more elements recited in independent Claims 1, 8 and 15 (as amended). The cited portions of the secondary references do not appear to disclose, teach or suggest these one or more elements, and therefore do not cure the deficiency (ies) noted in Rhee. Therefore, the combinations of Rhee and the secondary references (as set forth in the Office Action) do not disclose, suggest or teach the claimed invention.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 1-15 and 17-20.

## II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@munckcarter.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Carter Deposit Account No. 50-0208.

Respectfully submitted,

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